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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,555	08/05/2003	Takashi Ohno	1405.1073	7151
21171 7590 11/03/2010				
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SUITE 700				
1201 NEW YORK AVENUE, N.W.				
WASHINGTON, DC 20005				
EXAMINER				
WHIPPLE, BRIAN P				
ART UNIT		PAPER NUMBER		
24-48				
MAIL DATE		DELIVERY MODE		
11/03/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/633,555

Applicant(s)

OHNO ET AL.

Examiner

BRIAN P. WHIPPLE

Art Unit

2448

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-11, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-11, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 3-11, and 13-14 are pending in this application and presented for examination.

Response to Arguments

2. Applicant's arguments filed 8/26/10 have been fully considered, but they are not persuasive.

3. As to claim 1, the applicant argues Sugano teaches selecting "part of" watcher clients of the first client, whereas the examiner has stated Sugano is silent on this limitation. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Even assuming this is the case as alleged by the applicant, an argument that the primary art of Sugano teaches the concept relied upon in the secondary art of Olivier is not persuasive, as the combination of references would still disclose the subject matter as a whole in this instance.

4. Further regarding claim 1, the applicant argues Sugano fails to disclose “replacing an old identifier of the first client with a new identifier” and “replacing identifiers of all watcher clients with one or more identifiers of the selected identifier notification recipients.”

However, the applicant has provided no reasoning as to why this would be the case. The applicant has failed to contrast the claimed subject matter against the prior art by stating the differences between the sections relied upon and the claimed subject matter. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

5. Further regarding claim 1, the applicant goes on to argue Olivier is also silent on the features discussed in the preceding paragraph. However, as noted above, the applicant has failed to point out the supposed reasoning behind stating Sugano is silent on the claimed subject matter. Therefore, the examiner maintains it is taught by Sugano and whether or not Olivier addresses those limitations is irrelevant. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

6. Further regarding claim 1, the applicant argues the motivation behind combining the references is improperly based on hindsight reasoning and/or conclusory statements. In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, it would have been obvious to combine the references in order to provide users with greater control over transmission of electronic communications (thereby enabling a higher quality of interpersonal contact), create personalized and tunable groups, and reduce the quantity of unwanted electronic communications (Olivier: Col. 1, ln. 47, 51-52, and 59-61; Col. 3, ln. 37-54).

7. Finally regarding claim 1, the applicant argues Sugano and Olivier are silent on replacing the old watchers with the new watchers in the watcher list of the first client. However, the claim is directed to the replacing of an "an old identifier of the first client with

a new **identifier**, and replacing **identifiers** of all watcher clients with one or more **identifiers** of the selected notification recipients.” In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., replacing the old watchers with the new watchers in the watcher list of the first client) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 3-11, and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugano et al. (Sugano), U.S. Patent No. 6,205,478 B1, in view of Olivier, U.S. Patent No. 6,480,885 B1.

10. As to claim 1, Sugano discloses a client administration method of administering a group of clients (Abstract, ln. 1-3), each client providing presence information (Col. 7, ln. 47-49), the method comprising:

accepting a setting of presence information of the clients including a first client, and storing the presence information on a client by client basis (Col. 7, ln. 40-43 and 47-49; Col. 19, ln. 2-6);

storing a watcher list for each of clients in the clients group (Col. 24, ln. 37-43; Col. 27, ln. 55-66; Col. 29, ln. 20-23 and 34-36), the watcher list correlating at least one identifier of a watcher client with an identifier of a client owning the watcher list (Col. 16, ln. 28-30; Col. 24, ln. 37-43; Col. 27, ln. 55-66; Col. 29, ln. 20-23 and 34-36), each watcher client being provided with the presence information of a client owning the watcher list (Col. 18, ln. 65 – Col. 19, ln. 2; Col. 24, ln. 37-43; Col. 27, ln. 55-66; Col. 29, ln. 20-23 and 34-36);

accepting a change of an identifier of the first client (Fig. 2, item 7; Col. 19, ln. 12-25);

selecting watcher clients of the first client as one or more identifier notification recipients according to the change of the identifier of the first client (Fig. 2, item 7; Col. 19, ln. 12-25; Col. 23, ln. 36-43);

replacing, in a watcher list of the first client, an old identifier of the first client with a new identifier, and replacing identifiers of all watcher clients with one or more identifiers of

the selected notification recipients (Col. 22, ln. 19-22; Col. 24, ln. 37-43; Col. 27, ln. 55-66; Col. 29, ln. 20-23 and 34-36), and

transmitting a new identifier of the first client to one or more selected identifier notification recipients (Col. 22, ln. 6-18; Col. 23, ln. 36-43).

Sugano is silent on selecting a part of (emphasis added) watcher clients of the first client.

However, Olivier discloses selecting a part of watcher clients of a first client (Abstract, ln. 1-3 and 9-13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Sugano by selecting a part of watcher clients of the first client as taught by Olivier in order to provide users with greater control over transmission of electronic communications (thereby enabling a higher quality of interpersonal contact), create personalized and tunable groups, and reduce the quantity of unwanted electronic communications (Olivier: Col. 1, ln. 47, 51-52, and 59-61; Col. 3, ln. 37-54).

11. As to claim 3, Sugano and Olivier disclose the invention substantially as in parent claim 1, further comprising:

storing identifiers of subscriber clients so that each subscriber client is associated with at least one client that provides the presence information thereto, the subscriber client being

provided with the presence information of at least one client of the clients group (Sugano: Col. 7, ln. 47-49; Col. 16, ln. 28-30; Col. 18, ln. 65-67; Col. 19, ln. 1-2; Col. 27, ln. 55-66); and extracting a client to be an identifier notification recipient, the client being both a watcher client of the first client and a subscriber client of the first client (Sugano: Col. 23, ln. 36-43).

12. As to claim 4, Sugano and Olivier disclose the invention substantially as in parent claim 1, further comprising:

notifying the first client's watcher client of new presence information according to the setting of the presence information (Sugano: Col. 7, ln. 47-49; Col. 26, ln. 12-41);

storing a notification history of the presence information (Sugano: Col. 9, ln. 25-29; Col. 22, ln. 65-67; Col. 23, ln. 1-3); and

said selecting including extracting at least one of a plurality of watcher clients of the first client based on the notification history, and deciding to be one or more identifier notification recipients (Sugano: Col. 18, ln. 10-14; Col. 19, ln. 12-25; an update notification is transmitted to each of the user terminals corresponding to receiving users who previously received a corresponding transmitted UIO; transmitting based on previous recipients is an extraction step based on notification history).

13. As to claim 5, Sugano and Olivier disclose the invention substantially as in parent claim 1, further comprising:

administering distribution of text messages exchanged between the clients (Sugano: Fig. 3; Col. 21, ln. 39-48);

storing a distribution history of distributed text messages (Sugano: Fig. 3; Fig. 4; Col. 9, ln. 25-29; Col. 18, ln. 10-14; Col. 22, ln. 65-67; Col. 23, ln. 1-3); and

said selecting including extracting at least one of a plurality of watcher clients of the first client based on the distribution history, and deciding to be one or more identifier notification recipients (Sugano: Col. 18, ln. 10-14; transmitting based on previous recipients is an extraction step based on distribution history).

14. As to claim 6, Sugano and Olivier disclose the invention substantially as in parent claim 1, wherein:

said storing of the presence information of the clients includes associating the presence information with an access level, the access level limiting notification recipients of the presence information of the clients (Sugano: Col. 19, ln. 63-67; Col. 20, ln. 1-15);

the access level of each watcher client (Sugano: Col. 19, ln. 63-67; Col. 20, ln. 1-5) is stored; and

a portion of a plurality of watcher clients of the first client is determined to be the identifier notification recipients based on the access level of each watcher client (Sugano: Col. 20, ln. 30-61; Level 5 users are not issued a UIO and no items are accessible).

15. As to claim 7, Sugano and Olivier disclose the invention substantially as in parent claim 1, comprising:

transmitting display data for displaying the change of the identifier of the first client to one or more identifier notification recipients (Sugano: Col. 25, ln. 19-36).

16. As to claim 8, Sugano and Olivier disclose the invention substantially as in parent claim 1, comprising:

transmitting attribute information related to the change of the identifier of the first client to one or more identifier notification recipients (Sugano: Fig. 3; Col. 22, ln. 6-18).

17. As to claim 9, Sugano and Olivier disclose the invention substantially as in parent claim 8, comprising:

accepting registration of the attribute information (Sugano: Col. 22, ln. 19-22).

18. As to claims 10-11 and 13-14, the claims are rejected for reasons similar to claim 1 above.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the Notice of References Cited (PTO-892).

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN P. WHIPPLE whose telephone number is (571)270-1244. The examiner can normally be reached on Mon-Fri (8:30 AM to 5:00 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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